

REMARKS

Petition for Extension of Time Under 37 CFR 1.136(a)

It is hereby requested that the term to respond to the Examiner's Action of November 23, 2009 be extended one month, from February 23, 2010 to March 23, 2010.

The Commissioner is hereby authorized to charge the RCE filing fee, the extension fee, and any additional fees associated with this communication to Deposit Account No. 50-4364.

The Final Office Action Summary issued on November 23, 2009 indicates that claims 1 through 24 are pending in the application, that claims 8-10 and 19-23 are withdrawn from consideration, and that claims 1-7, 11-18 and 24 are rejected. However, on page 2 of the Office Action, the Office properly indicates that claims 8-10 and 19-23 have been cancelled, and that claims 1-7, 11-18 and 24 are pending.

Also on page 2 of the Action, the Office indicates that applicant's *amendment* to claims 21-23 are sufficient to overcome the claim objections and rejection under 35 U.S.C. §101. Applicant believes the Office has considered the *cancellation* of these claims as overcoming these objections/rejections.

Rejections under 35 U.S.C. §103

On page 3 of the Office Action, the Office rejected claims 1-5, 11-18, and 24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0036914 to Fitzpatrick et al. in view of U.S. Patent No. 6,480,831 to Cordery et al. On page 9 of the Office Action, the Office rejected claims 6-7 under 35 U.S.C. §103(a) as being

unpatentable over Fitzpatrick in view of Cordery and further in view of U.S. Patent No. 4,390,981 to Wood et al.

Although Applicant stands by its previously-presented arguments that the combination of art cited by the Examiner fails to teach or suggest the claimed invention, in order to further prosecution of the present case, Applicant hereby amends independent claims 1 and 24 to further recite that the digests of contacts that are generated by each device include normalized versions of the contact entries. Support for this amendment can be found at paragraph [0009] of the published application corresponding to the present application (US 2007/0208747). Applicant submits that, in addition to failing to teach or suggest any need or desire to generate *digests* of the contacts in the respective contacts stores and to only transfer the *digests* between devices to enable discovery of common contacts, none of the prior art teaches or suggests normalizing the contact entries in digests. Among other things, this normalization resolves any issue that may occur because the devices store the same data in slightly different formats (e.g., one might use parenthesis around an area code in a phone number while another might simply put a hyphen between the area code and the exchange designation).

For the purpose of completeness, Applicant resubmits the previously presented arguments below, modified to include the further argument set forth above with respect to the now-claimed normalization element.

The Office asserted that Cordery, with its teaching of transmitting keys from a postage metering device to a remote data center, renders the claimed invention obvious under 35 U.S.C. §103(a) when combined with the teachings of Fitzpatrick. Applicant respectfully disagrees with this assertion, since neither reference provides any reason that would have

prompted a person of ordinary skill in the relevant field to reasonably combine the elements in the way the claimed new invention does, and thus the combination does not meet the requirements of KSR (*KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007)).

The claimed invention enables the communication of contact information between a device and a further device, and the claims include a hash key to be transmitted to the further device, which causes each of the devices to generate digests of contact entries in their contact stores using the hash key. The digests include normalized versions of the contact information. The digests generated by the further device are transmitted to the (first) device, and the digests are used to compare the contact stores. In the claimed invention, when the users decide to exchange contacts information, the respective devices each generate digests of the contacts in the respective contacts stores, normalized as indicated above, and only the digests are transferred between devices and used to discover common contacts. Therefore, the common contacts can be discovered without the transfer of the potentially sensitive contacts information. This is a particularly beneficial way of discovering common contacts, and is not disclosed or suggested by a combination of Cordery and Fitzpatrick, as is suggested by the Office.

As Applicant acknowledged previously, Fitzpatrick does appear to disclose a type of mutual contacts discovery system. In the examples described in Fitzpatrick, common contacts between two devices can be notified using a contact clearing house, as described with reference to Figures 1 to 4, or directly between devices, as described with reference to Figure 5. However, nothing in Fitzpatrick, discusses, mentions, or indicates any need or

desire to generate *digests* of the contacts in the respective contacts stores and to only transfer the *digests* between devices to enable discovery of common contacts, nor does Fitzpatrick contain any teaching or suggestion of normalizing the contacts. Further, nothing in Fitzpatrick, discusses, mentions, or indicates any need or desire to perform a discovery process using a hash key transmitted from one device to the other device.

The addition of Cordery fails to supply the reasons, required by KSR, for providing such features (features which are claimed in all of the pending claims). First, Cordery has nothing whatsoever to do with identifying common contact information contained on two devices; Cordery is concerned with securely transmitting a key from a first device to a second device, i.e., from a postage meter to a remote data center. It does not in any way involve discovery of contact information on one device by another device; Cordery is concerned with preventing the printing of postage by an unauthorized computer due to the use of fraudulent verification information, and thus nothing in Cordery would reasonably suggest generating digests of *contacts* in contacts stores of two devices and to only transfer the *digests* between devices to enable discovery of common contacts, let alone that such digests contain normalized versions of the contact information. As such, the combination proposed by the Office is improper under 35 U.S.C. §103.

The addition of Wood, like Cordery, also contains no teaching or suggestion of generating digests of *contacts* in contacts stores of two devices and to only transfer the *digests* between devices to enable discovery of common contacts; clearly, without a teaching or suggestion of digests of contacts, Wood cannot possibly contain a teaching or suggestion of normalized contacts as is now claimed.

In view of the arguments submitted herein, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-7, 11-18 and 24 under 35 USC §103.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge the RCE filing fee, the extension fee, and any additional fees associated with this communication to applicant's Deposit Account No. 50-4364.

Respectfully submitted

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Date

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